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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/421,055	04/12/1995	MICHAEL A. JOHNSON	49286USA9C	5806

32692 7590 04/12/2006

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EXAMINER	
JOHNSTONE, ADRIENNE C	
ART UNIT	**PAPER NUMBER**
1733	

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/421,055	JOHNSON ET AL.	
	Examiner	Art Unit	
	Adrienne C. Johnstone	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 August 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-13,16-24,26-29 and 31-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-13,16-24,26-29 and 31-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *020205; 080204*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim 29 is rejected under 35 U.S.C. 102(b) as being anticipated by Sinclair (3,616,192) or, alternatively, Conley et al. (3,679,510).

See Sinclair entire document: a transparent polyvinyl fluoride film is printed on one surface with a decorative ink pattern of the claimed thermosetting epoxy-polyester blend and then a layer of pigmented thermosetting polyester adhesive is solvent-coated and dried on the decorative surface (which surface is therefore "paint-receptive"), the resulting film being laminated under heat and pressure to a substrate. The transparent film protects and maintains the integrity of the decorative ink pattern and therefore must be "dimensionally stable" and retain a "substantially smooth surface topography", and the film must inherently exert a surface tension which prevents the flow of the adhesive substantially beyond the film in order to maintain the attractive appearance of the laminate; burden is therefore shifted to applicants to show lack of inherency (MPEP 2112-2112.02).

Alternatively, see Conley et al. entire document: a smooth transparent polyvinyl fluoride film is chemically activated to receive a decorative ink pattern of the claimed thermosetting epoxy-polyester blend printed thereon and then a layer of pigmented thermosetting polyester adhesive is applied on the decorative surface (which surface is therefore "paint-receptive"), the resulting film being conventionally laminated (under heat and pressure) to a thermoplastic intermediate layer and the film in the final product having a smooth outer surface and a clear, undistorted decorative pattern ("dimensionally stable"). The film must inherently exert a surface tension which prevents the flow of the adhesive substantially beyond the film in order to maintain the attractive appearance of

the laminate; burden is therefore shifted to applicants to show lack of inherency (MPEP 2112-2112.02).

3. Claims 29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimizu et al. (5,126,188) (note that if this rejection is overcome by means other than amending the claims to distinguish over the reference the examiner will consider 102(b) rejections based on the Japanese equivalents JP 3-10545 U, JP 3-208221 A, and JP 4-28724).

See col. 2 lines 34-46, col. 2 line 64 - col. 5 line 68, and Examples 1-10: film-coated shaped material used for sealing an electronic part is "blanked in a shape in conformity with the configuration of the portion of the electronic part to be sealed" (col. 5 lines 10-13), has "high shape retentivity" (col. 2 lines 34-36), and comprises a plastic film "diminished in warping property" (col. 4 lines 63-64)(therefore the film is "dimensionally stable" by applicants' definition, specification p. 27 lines 11-19 and p. 28 lines 9-13, and could have no substantial shrinkage during the heating step due to the required coverage of the portion of the electronic part to be sealed); the plastic film "gives excellent smoothness and gloss to the surface of the cured seal" (substantially smooth surface topography substantially retained during cooling) and has a thickness of 10 to 1000μ to control by surface tension the flow of the sealing material when melted by heating and thereafter cured and adhered by continued heating (col. 4 lines 48-56 and col. 5 lines 24-68); an exemplary sealing material is a thermosetting epoxy-polyester blend (Examples 1, 3, 5, 7, and 9: thermoplastic polyester is highly crystalline, so blend with epoxy is semicrystalline). Note that the open instant language "said film comprising a substantially smooth, paint-receptive surface comprising a thermosetting epoxy-polyester blend" does not exclude the above method wherein the thermosetting epoxy-polyester blend is both the melt-flowable composition and the surface layer of the film comprising the thermosetting epoxy-polyester blend: both the exemplary film and the exemplary film-coated

shaped material have a substantially constant thickness (col. 4 lines 48-52, col. 5 lines 10-23 and col. 7 line 63 - col. 8 line 2) so the thermosetting epoxy-polyester blend side of the film-coated shaped material has a "substantially smooth" surface, and since the thermosetting epoxy-polyester blend is an adhesive material it is necessarily "paint-receptive" to some degree (applicants are not yet claiming a step of painting the "paint-receptive" surface). As to claim 31, the plastics film may be polyester (col. 4 lines 48-62) which one of ordinary skill in the art would understand to necessarily have some orientation in order to have the required dimensional stability. Note that with respect to any inherent feature discussed above, the reasoning supplied in the discussion provides sufficient basis for the examiner to infer that the feature is inherent; burden is therefore shifted to applicants to show lack of inherency (see for example the case law cited in MPEP 2112-2112.02).

4. Claims 6, 8, 16, 17, 19-24, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Application 3-273975.

See the abstract, figures, and translation: the seam of step-jointed steel automobile body plates 1 and 2 is sealed by tape 4 comprising hot-melt base film 4a such as a nylon or EVA (ethylene-vinyl alcohol) film and thermosetting resin adhesive 4b such as thermosetting epoxy resin adhesive applied on the base film at a thickness of 30 to 100 μm (0.03 to 0.1 mm), then after baking the assembly it is joined with with intercoating film 5 and overcoating film 6; the base film confines the adhesive to the seam underneath the film in order to completely seal the seam without excess adhesive outside the seal, thereby avoiding any seal finishing process and providing an attractive appearance by preventing unevenness in the film coatings (translation p. 4), the tape is thin enough to conform to the seam without showing through the coatings (translation p. 7), and the tape softens (but does not melt) during baking but hardens after cooling to ordinary temperature (translation p. 8) (therefore the base film is "dimensionally stable" by applicants' definition, specification p. 27 lines

11-19 and p. 28 lines 9-13, and could have no substantial shrinkage during the baking step due to the required even appearance of the coatings). As to claim 16, see the alternative step joint arrangement in Figure 2. As to claims 17 and 19, see the alternative step joint arrangement in Figure 2: one of ordinary skill in the art would have expected the coating films 5 and 6 in this automobile body environment to be the typical paint layer/clearcoat layer protecting the steel automobile body plates from rust. Note that with respect to any inherent feature discussed above, the reasoning supplied in the discussion provides sufficient basis for the examiner to infer that the feature is inherent; burden is therefore shifted to applicants to show lack of inherency (see for example the case law cited in MPEP 2112-2112.02).

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 6, 8, 12, 13, 16, 17, 19-24, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A.

See paragraph 4 above: it would have been obvious to one of ordinary skill in the art to follow the teachings of the reference by making the base film confine the adhesive to the seam underneath the film in order to completely seal the seam without excess adhesive outside the seal, thereby avoiding any seal finishing process and providing an attractive appearance by preventing unevenness in the film coatings (translation p. 4), and by making the base film dimensionally stable with no substantial shrinkage during the baking step in order to provide the required even appearance of the coating films. As to claims 12 and 13, oriented polyethylene terephthalate film such as MYLAR is notoriously well known to have dimensional stability, therefore it would have been obvious to one of ordinary skill in the art to use such notoriously well known dimensionally

stable oriented polyethylene terephthalate film as the hot-melt base film in the above method. As to claim 16, see the alternative step joint arrangement in Figure 2. As to claims 17 and 19, see the alternative step joint arrangement in Figure 2: it would have been obvious to one of ordinary skill in the art to provide the coating films 5 and 6 in this automobile body environment as the conventional paint layer/clearcoat layer protecting the steel automobile body plates from rust.

7. Claims 7, 9, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A as applied to claims 6, 8, 12, 13, 16, 17, 19-24, and 34 above, and further in view of Schappert et al. (4,822,683) and Manser et al. (4,920,182).

It is well known to blend such thermosetting epoxy resin adhesive with thermoplastic polyester resin (which is highly crystalline, making the blend semi-crystalline) in order to maintain good adhesive properties while minimize shrinkage of the adhesive upon curing and improving flexibility, as evidenced by Schappert et al. (col. 1 lines 10-55 and col. 6 lines 20-41) and Manser et al. (col. 1 lines 6-55 and col. 8 line 62 - col. 9 line 8) for example; it would therefore have been obvious to one of ordinary skill in the art to use such a well known blend as the adhesive in the above method in order to maintain good adhesive properties while minimize shrinkage of the adhesive upon curing and improving flexibility.

8. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A as applied to claims 6, 8, 12, 13, 16, 17, 19-24, and 34 above, and further in view of Leatherman et al. (4,877,679) and Leatherman et al. (4,892,779).

It would have been obvious to one of ordinary skill in the art to make the hot-melt base film from ultra high molecular weight microporous polyolefin because such film has the required dimensional stability (does not melt and flow) and is well suited to accept coatings such as printing inks (Leatherman et al. '679 col. 1 lines 5-10, col. 2 lines 26-35, col. 12 lines 3-44, and col. 12 line 62

- col. 13 line 3 and Leatherman et al. '779 col. 1 lines 10-15, col. 1 line 60 - col. 2 line 2, col. 11 line 47 - col. col. 12 line 34, and col. 12 line 52 - col. 13 line 13).

9. Claims 18, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A as applied to claims 6, 8, 12, 13, 16, 17, 19-24, and 34 above, and further in view of Manser et al. (4,920,182) and Japanese Patent Application 58-217516 A.

The only difference between the above method and the claimed method is the substantially smooth, paint-receptive film surface comprising a thermosetting epoxy-polyester blend, however the claimed thermosetting epoxy-polyester blend is well known as a paint or ink (pigmented) composition having good adhesion and flexibility, as evidenced by Manser et al. (col. 1 lines 6-55, col. 7 lines 31-39, and col. 8 line 62 - col. 9 line 8) and JP '516 (abstract) for example; it would therefore have been obvious to one of ordinary skill in the art to use such well known paint or ink composition as the paint layer on the base film in the above method.

As to claim 31, oriented polyester film such as MYLAR is notoriously well known to have dimensional stability, therefore it would have been obvious to one of ordinary skill in the art to use such notoriously well known dimensionally stable oriented polyester film as the coating film in the above method.

10. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A as applied to claims 6, 8, 12, 13, 16, 17, 19-24, and 34 above, and further in view of European Patent Application 0 384 598 A1.

It is well known in such sealing tapes to provide the melt-flowable adhesive layer with an outer layer of pressure-sensitive adhesive in order to precisely position the tape and maintain the position during melt-flowing of the melt-flowable adhesive layer, as evidenced by EP '598 (p. 1 line

4 - p. 2 line 3) for example; it would therefore have been obvious to one of ordinary skill in the art to provide the melt-flowable adhesive layer in the above method with such a well known outer pressure-sensitive adhesive layer in order to precisely position the tape and maintain the position during melt-flowing of the melt-flowable adhesive layer.

11. Claims 26, 27, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A as applied to claims 6, 8, 12, 13, 16, 17, 19-24, and 34 above, and further in view of Japanese Patent Application 1-152049 A.

A roof ditch is a notoriously well known vehicle step joint, as evidenced by JP '049 (translation pp. 2-4 and Figures 2-5) for example; it would therefore have been obvious to one of ordinary skill in the art to use the above step joint method when making such a notoriously well known roof ditch step joint. As to claim 33, one of ordinary skill in the art would have readily recognized that the thickness of the adhesive layer or layers in such as roof ditch would have to be large enough to seal the step joint but not so large as to substantially fill the roof ditch thereby marring the appearance of the vehicle, rendering the adhesive thickness a result-effective variable to be optimized by one of ordinary skill in the art (MPEP 2144.05(II)); it would therefore have been obvius to one of ordinary skill in the art to optimize the thickness of the adhesive to within the claimed range in the above method when making a roof ditch step joint. This is especially true since the depth of a roof ditch in an automobile is typically on the order of 10 mm, the upper limit of the claimed range.

12. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 3-273975 A in view of Schappert et al. (4,822,683) and Manser et al. (4,920,182) as applied to claims 7, 9, and 28 above, and further in view of Japanese Patent Application 1-152049 A.

A roof ditch is a notoriously well known vehicle step joint, as evidenced by JP '049 (translation pp. 2-4 and Figures 2-5) for example; it would therefore have been obvious to one of ordinary skill in the art to use the above step joint method when making such a notoriously well known roof ditch step joint.

13. Claims 6, 8, 12, 13, 16, 17, 20-24, 26, 27, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 1-152049 A in view of Shimizu et al. (5,126,188) and Reaney (5,162,149).

The only difference between the prior art roof ditch sealing method and the claimed method is that the sealing tape forming the substantially smooth, paint-receptive surface for subsequent painting is not provided with a dimensionally stable film backing, as evidenced by JP 1-152049 A (translation and figures) for example; however, it is well known to provide such sealing tape with a dimensionally stable film backing (no substantial shrinkage) in order to confine the adhesive to the desired area to be sealed, as evidenced by Shimizu et al. (discussed in paragraph 3 above) and Reaney (col. 1 line 12 - col. 2 line 14) for example. It would therefore have been obvious to one of ordinary skill in the art to provide the sealing tape in the prior art roof ditch sealing method with a dimensionally stable film backing having no substantial shrinkage in order to confine the adhesive to the desired area to be sealed.

Applicants have added the limitation that the melt-flowable layer has a thickness of at least 0.05 mm (the upper limit is rendered moot by the recitation of "at least" before the range; not new matter because specification p. 10 lines 3-10 discloses the thickness range of about 0.05mm to 25 mm and that the thickness can vary depending upon the intended use but must be great enough to flow and level out over dents, bumps, and other surface imperfections or to fill in gaps between joints, thus inherently disclosing no required upper limit on the thickness), however the JP '049

melt-flowable layer performs the same function as applicants' melt-flowable layer and therefore there is a reasonable basis for the examiner to infer that either it would inherently have a thickness within the broad open-ended range of at least 0.05 mm or it would have been obvious to provide it with a thickness within the broad open-ended range of at least 0.05 mm in order to assure that the melt-flowable material flows around and seals the welded step joint of the roof ditch; burden is therefore shifted to applicants to show an unobvious difference (see for example the case law cited in MPEP 2112-2112.02).

As to claims 12 and 13, oriented polyethylene terephthalate film such as MYLAR is notoriously well known to have dimensional stability, therefore it would have been obvious to one of ordinary skill in the art to use such notoriously well known dimensionally stable oriented polyethylene terephthalate film as the dimensionally stable film backing in the above method.

As to claim 33, one of ordinary skill in the art would have readily recognized that the thickness of the adhesive layer or layers in such as roof ditch would have to be large enough to seal the step joint but not so large as to substantially fill the roof ditch thereby marring the appearance of the vehicle, rendering the adhesive thickness a result-effective variable to be optimized by one of ordinary skill in the art (MPEP 2144.05(II)); it would therefore have been obvious to one of ordinary skill in the art to optimize the thickness of the adhesive to within the claimed range in the above method when making a roof ditch step joint. This is especially true since the depth of a roof ditch in an automobile is typically on the order of 10 mm, the upper limit of the claimed range.

14. Claims 7, 9, 28, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 1-152049 A in view of Shimizu et al. (5,126,188) and Reaney (5,162,149) as applied to claims 6, 8, 12, 13, 16, 17, 20-24, 26, 27, 33, and 34 above, and further in view of Schappert et al. (4,822,683) and Manser et al. (4,920,182).

It is well known to use as a sealing adhesive a blend thermosetting epoxy resin adhesive with thermoplastic polyester resin (which is highly crystalline, making the blend semi-crystalline) in order to improve the mechanical properties of the adhesive, as evidenced by Shimizu et al., and it is well known to use such blends as adhesives in order to maintain good adhesive properties while minimize shrinkage of the adhesive upon curing and improving flexibility, as evidenced by Schappert et al. (col. 1 lines 10-55 and col. 6 lines 20-41) and Manser et al. (col. 1 lines 6-55 and col. 8 line 62 - col. 9 line 8) for example; it would therefore have been obvious to one of ordinary skill in the art to use such a well known blend as the sealing adhesive in the above method in order to improve the mechanical properties of the adhesive, maintain good adhesive properties while minimize shrinkage of the adhesive upon curing, and improving flexibility.

15. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 1-152049 A in view of Shimizu et al. (5,126,188) and Reaney (5,162,149) as applied to claims 6, 8, 12, 13, 16, 17, 20-24, 26, 27, 33, and 34 above, and further in view of Leatherman et al. (4,877,679) and Leatherman et al. (4,892,779).

It would have been obvious to one of ordinary skill in the art to make the dimensionally stable film backing from ultra high molecular weight microporous polyolefin because such film has the required dimensional stability (does not melt and flow) and is well suited to accept coatings such as printing inks (Leatherman et al. '679 col. 1 lines 5-10, col. 2 lines 26-35, col. 12 lines 3-44, and col. 12 line 62 - col. 13 line 3 and Leatherman et al. '779 col. 1 lines 10-15, col. 1 line 60 - col. 2 line 2, col. 11 line 47 - col. col. 12 line 34, and col. 12 line 52 - col. 13 line 13).

16. Claims 18, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 1-152049 A in view of Shimizu et al. (5,126,188) and Reaney (5,162,149)

as applied to claims 6, 8, 12, 13, 16, 17, 20-24, 26, 27, 33, and 34 above, and further in view of Manser et al. (4,920,182) and Japanese Patent Application 58-217516 A.

The only difference between the above method and the claimed method is the substantially smooth, paint-receptive film surface comprising a thermosetting epoxy-polyester blend, however the claimed thermosetting epoxy-polyester blend is well known as a paint or ink (pigmented) composition having good adhesion and flexibility, as evidenced by Manser et al. (col. 1 lines 6-55, col. 7 lines 31-39, and col. 8 line 62 - col. 9 line 8) and JP '516 (abstract) for example; it would therefore have been obvious to one of ordinary skill in the art to use such well known paint or ink composition as the paint layer on the film backing in the above method.

17. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 1-152049 A in view of Shimizu et al. (5,126,188) and Reaney (5,162,149) as applied to claims 6, 8, 12, 13, 16, 17, 20-24, 26, 27, 33, and 34 above, and further in view of Japanese Patent Application 3-273975 A.

EVA (ethylene-vinyl alcohol) film is recognized as a dimensionally stable film backing material in sealing step joints in automobile bodies, as evidenced by JP '975 (discussed in paragraph 4 above) for example; it would therefore have been obvious to one of ordinary skill in the art to use EVA film as the dimensionally stable backing film in the above roof ditch step joint method.

18. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 1-152049 A in view of Shimizu et al. (5,126,188) and Reaney (5,162,149) as applied to claims 6, 8, 12, 13, 16, 17, 20-24, 26, 27, 33, and 34 above, and further in view of European Patent Application 0 384 598 A1.

It is well known in such sealing tapes to provide the melt-flowable adhesive layer with an outer layer of pressure-sensitive adhesive in order to precisely position the tape and maintain the

position during melt-flowing of the melt-flowable adhesive layer, as evidenced by EP '598 (p. 1 line 4 - p. 2 line 3) for example; it would therefore have been obvious to one of ordinary skill in the art to provide the melt-flowable adhesive layer in the above method with such a well known outer pressure-sensitive adhesive layer in order to precisely position the tape and maintain the position during melt-flowing of the melt-flowable adhesive layer.

19. Claims 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al. (5,126,188) (note that if this rejection is overcome by means other than amending the claims to distinguish over the reference the examiner will consider 102(b) rejections based on the Japanese equivalents JP 3-10545 U, JP 3-208221 A, and JP 4-28724).

See paragraph 3 above: it would have been obvious to one of ordinary skill in the art to follow the teachings of the reference by making the film "dimensionally stable" by applicants' definition, specification p. 27 lines 11-19 and p. 28 lines 9-13, with no substantial shrinkage during the heating step in order to maintain the required coverage of the portion of the electronic part to be sealed, and to provide the film with a substantially smooth surface topography before bonding in order to obtain the required excellent smoothness and gloss. As to claim 31, oriented polyester film such as MYLAR is notoriously well known to have dimensional stability, therefore it would have been obvious to one of ordinary skill in the art to use such notoriously well known dimensionally stable oriented polyester film as the polyester film in the above method.

20. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sinclair (3,616,192) or, alternatively, Conley et al. (3,679,510), in view of U.S. Defensive Publication T867,006, Kline et al. (2,631,947), and Douglas et al. (2,647,849).

See paragraph 2 above: it is well known in such laminations to have the adhesive confined by the film in order to maintain the attractive appearance of the laminate, as evidenced by U.S.

Defensive Publication T867,006 (p. 2 lines 1-26), Kline et al. (col. 1 line 44 - col. 2 line 15 and col. 7 line 58 - col. 8 line 2), and Douglas et al. (col. 1 line 48 - col. 2 line 36) for example; it would have been obvious to one of ordinary skill in the art to limit the flow of the adhesive to the area underneath the film in order to maintain the decorative appearance of the laminate.

21. Claims 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Artzt (2,739,919) in view of Manser et al. (4,920,182) and Japanese Patent Application 58-217516 A.

The only difference between the Artzt method and the claimed method is the film surface comprising a thermosetting epoxy-polyester blend (reference silent as to the composition of the inked or painted impression on the surface of the film). Specifically, see the entire Artzt disclosure: coating film 24 is cast on the smooth surface of carrier strip 12 and solidified (cured) before depositing thereon an adhesive film of the thermal fusion (thermoplastic) or thermosetting type (therefore the film is "dimensionally stable" by applicants' definition, specification p. 27 lines 11-19 and p. 28 lines 9-13); coating film 24 with the adhesive film thereon is bonded to a fabric or material to be coated 34 under heat and pressure sufficient to fuse the adhesive to the fabric or material being coated 34, leaving the surface of the coating film smooth after bonding (col. 4 lines 50-54); after the adhesive passes under doctor blade 20 past guides 18 it is confined within the surface of the coating film 24, thus the coating film 24 ensures complete adhesive coverage of the surface of the fabric or material being coated 34 (col. 3 lines 19-54); an inked or painted impression can be applied to the smooth surface of the coating film 24 simultaneously with the formation of the coating film 24 (col. 4 lines 32-37); coating film 24 by definition does not shrink once solidified (cured), and further one of ordinary skill in the art would understand that the coating film 24 does not shrink during the bonding step in view of the disclosure that if the fabric or material to be coated 34 would normally shrink during the bonding step it must be pre-shrunk so that "no distortion of the

lamination will occur" during the bonding step "to ensure the dimensional stability of the lamination" (col. 3 line 66 - col. 4 line 2). Note that with respect to any inherent feature discussed above, the reasoning supplied in the discussion provides sufficient basis for the examiner to infer that the feature is inherent; burden is therefore shifted to applicants to show lack of inherency (see for example the case law cited in MPEP 2112-2112.02). In any case, it would have been obvious to one of ordinary skill in the art to follow the teachings of the reference by ensuring that the coating film 24 confines the adhesive within the borders of the coating film 24, thus providing complete coverage by the adhesive of the fabric or material being coated 34, and that the coating film 24 does not shrink during the bonding step so that "no distortion of the lamination will occur" during the bonding step "to ensure the dimensional stability of the lamination" (col. 3 line 66 - col. 4 line 2).

The claimed thermosetting epoxy-polyester blend is well known as a paint or ink (pigmented) composition having good adhesion and flexibility, as evidenced by Manser et al. (col. 1 lines 6-55, col. 7 lines 31-39, and col. 8 line 62 - col. 9 line 8) and JP '516 (abstract) for example; it would therefore have been obvious to one of ordinary skill in the art to use such well known paint or ink composition as the inked or painted impression on the film in the above method.

As to claim 31, oriented polyester film such as MYLAR is notoriously well known to have dimensional stability, therefore it would have been obvious to one of ordinary skill in the art to use such notoriously well known dimensionally stable oriented polyester film as the coating film in the above method.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (571) 272-1218. The examiner can normally be reached on Monday-Friday, 10:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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April 10, 2006